

Appl. No. : 10/632,531
Filed : August 1, 2003

REMARKS

Claim 15 has been amended to incorporate the limitations previously found in Claim 19. Specifically, R₄ in Claim 15 is now specified as being a tert-butyl group. The proviso previously found in Claim 15 has been deleted as it is no longer necessary. Claim 15 has also been amended to specify optional substitution groups. Claim 20 has similarly been amended to specify substitution groups. Claims 18 and 19 have been canceled. Claim 25 has been amended to remove t-butyl phenylahistin.

Support for the above-referenced amendments may be found in the application as filed, for example, in the original claims and page 19 of the specification. Furthermore, the Applicants note that t-butyl dehydrophenylahistin is recited in Claim 25 by its reference to KPU-2. Claims 15-17 and 20-25 remain pending in the application. The Applicants have carefully considered all of the Examiner's rejections but respectfully submit that the claims are allowable for at least the following reasons.

Rejections under § 112 – Indefiniteness

The Examiner rejected Claims 15-25 under 35 U.S.C. § 112, ¶ 2 as being indefinite. The Examiner asserted that the use of the term "substituted" was unclear based on the definition in the specification. The Examiner indicated that the indefiniteness rejection would be overcome by including a list of specific substitution groups found in the specification on page 19. The Applicants have accordingly amended Claims 15 and 20 to specify the disclosed optional substitution groups, and have not narrowed these claims. As such, the Applicants respectfully submit that they have met the Examiner's requirements and overcome the rejection.

The Examiner also asserted that Claim 15 was indefinite based on an alleged contradiction in the proviso. The Applicants have removed the proviso from Claim 15, thereby rendering this rejection moot.

The Examiner also asserted that Claim 19 was indefinite because the saturated alkyl was allegedly unclear. The Applicants have canceled Claim 19, thereby rendering this rejection moot.

The Examiner also asserted that Claim 25 was indefinite because the compounds KPU-11 and KPU-66 were not defined in the specification. The Applicants refer the Examiner to page 73, table row 2, where the structure of KPU-11 is identified, and to page 83, table row 3, where

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the structure of KPU-66 is identified. Accordingly, the Applicants respectfully submit that Claim 25 is definite; KPU-11 and KPU-66 are specified. The Examiner also argued that the recitation of t-butyl-phenylahistin in Claim 25 lacked antecedent basis in Claim 15. The Applicants have removed t-butyl-phenylahistin from Claim 25, thereby rendering this rejection moot. The Applicants note that t-butyl-dehydrophenylahistin is recited in Claim 25 by its reference to KPU-2.

Rejections under § 102

The Examiner rejected Claims 15-17, 19, and 22 under 35 U.S.C. § 102(b) as being anticipated by Augustin (1966); Claims 15, 17, 18, 19, and 22 under 35 U.S.C. § 102(b) as being anticipated by Küster et al. (1927); and Claims 15-17, 19, and 22-24 under 35 U.S.C. § 102(b) as being anticipated by Canadian Application No. 2,403,790 (Kanzaki et al.). However, no compound in any of the cited references falls within the scope of Claim 15 as currently amended. Specifically, Claim 15 requires that R₄ be a tert-butyl group, which is not present in any compound disclosed in the cited references. Accordingly, the Applicants respectfully submit that the claims are not anticipated by any of Augustin, Küster et al., or Kanzaki et al.

Rejections under § 103

The Examiner rejected Claims 19 and 25 under 35 U.S.C. § 103(a) as being obvious over Kanzaki et al. Claim 19 has been canceled but its limitations have been incorporated into Claim 15. The Examiner argues that while Kanzaki et al. does not specifically disclose tert-butyl compounds, it does generically suggest that its R₇ substituent can be alkyl and that alkyls can, in general, include tert-butyl. Furthermore, the Examiner points to an n-butyl compound disclosed by Kanzaki et al.

Attached is a declaration of the present inventor, Dr. Yoshio Hayashi, in which he compared the P-388 cytotoxicity of n-butyl phenylahistin to tert-butyl phenylahistin. The results demonstrate that the tert-butyl compound has more than an order of magnitude greater cytotoxic activity. Dr. Hayashi further declares that based on this data, he would expect that tert-butyl dehydrophenylahistin and its analogs would exhibit marked superiority over n-butyl dehydrophenylahistin and corresponding n-butyl analogs. The Applicants respectfully submit that this evidence of the superiority of tert-butyl compounds overcomes any assertion of *prima*

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facie obviousness based on the n-butyl compound of Kanzaki et al. and that the claims are therefore not obvious.

CONCLUSION

The Applicants respectfully submit that by the foregoing amendments and remarks they have overcome all of the Examiner's rejections and that the Application is fully allowable. Applicants therefore respectfully request that the Examiner issue a Notice of Allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

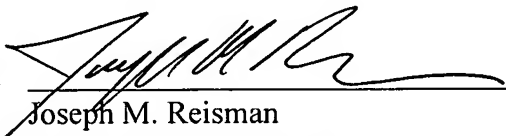
Respectfully submitted,

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Dated: _____

March 3, 2006

By: _____



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